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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,698	02/06/2004	Charles C. Hart	CBUS-1631-AV	4710

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EXAMINER

WOODALL, NICHOLAS W

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/664,698

Applicant(s)

HART ET AL.

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 36-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/06/2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/24/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 37 and 38, the examiner is unable to find support for the subject matter in the claims. The examiner is able to find support for only one jaw having the increased traction, but the examiner is unable to find support for the first and second pads having a first traction characteristic. Furthermore, the examiner is also unable to find support for the first and second tissue contacting surfaces of the projections have a second traction characteristic that is different than the first traction characteristic of the first and second pads.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Klieman (U.S. Patent 5,171,253).

Regarding claim 1, Klieman discloses a device comprising a substrate having a surface capable of facing the tissue of a patient, a multiplicity of bristles each having a column strength and extending outwardly from the particular surface of the substrate wherein each of the bristles have a generally straight configuration. Regarding the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Klieman, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

5. Claims 36-40 and 42-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogarty (U.S. Patent 3,503,398).

Regarding claim 36, Fogarty discloses a device comprising opposable first and second pads formed from a resilient material, a multiplicity of first projections disposed to extend outwardly of the first pad and provide a first tissue contacting surface, and a multiplicity of second projections disposed to extend outwardly of the second pad and to

provide a second tissue contacting surface, wherein the first and second projections interrelate to facilitate traction when the pads are moved toward one another. Regarding claim 37, Fogarty discloses a device wherein the first and second pads have particularly smooth surfaces, which are adapted to face the tissue of the patient and have a first traction characteristic. The examiner is interpreting the word particular to mean specific, therefore the examiner is interpreting the claim limitation to be that the first and second pads have a specific surface having a first traction characteristic. Regarding claim 38, Fogarty discloses a device wherein each of the first and second tissue contacting surfaces has a traction characteristic different from the first traction characteristics. The examiner believes that the smooth surface of the pad will have a low surface traction characteristic and the projections will have a higher surface traction characteristic especially in the direction of the sharp points of the projections. Regarding claims 39-41, Fogarty discloses a device wherein the projections are arranged in a pattern. In Figure 5a Fogarty discloses the projections being in a waffle like pattern and in Figure 7 Fogarty shows the projections being in a saw-tooth like pattern. Regarding claim 42, Fogarty discloses a device wherein each of the first and second projections has an axis and a radial cross-section of either a polygonal configuration or an irregular configuration. Fogarty discloses projections wherein the radial cross-section is an irregular configuration. Regarding claim 43, Fogarty discloses a device wherein the axis of at least one of the projections is disposed at an angle to the particularly smooth surface of at least one of the first or second pads. Fogarty discloses the projections are inclined at an angle of approximately 45 degrees relative to the particularly smooth

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surface of the first or second pads. Regarding claim 44, Fogarty discloses a device further comprising opposable first and second jaws to fixedly support the first and second pads. Regarding claim 45, Fogarty discloses a device wherein the pattern of the projections provides traction with the tissue of a first magnitude in a first direction and provides traction with the tissue of a second magnitude in a second direction, wherein the first magnitude is different from the second magnitude and the first direction is different from the second direction (column 3 lines 31-43). Regarding claim 46, Fogarty discloses a device wherein at least one of the first projections and at least one of the second projections extend between a first end and a second end, wherein the first end is disposed in proximity to the particular surface of the first pad and the second pad and the second end extending outwardly of the first and second pad such that the radial cross-section of the projections progressively decrease in area from the first end to the second end. Fogarty discloses in the figures that the projections are substantially pyramid shaped and extend from a base on the surface of the pads to points extended away from the surface of the pads, therefore the cross-section area of the projections would progressively decrease from the first end or base end of the projections towards the second end or tip of the projections.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fogarty (U.S. Patent 3,503,398).

Fogarty discloses the invention as claimed except for the radial cross-section of the first and second projections being ovular. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the first and second projections of the device of Fogarty with a ovular radial cross-section, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing projections in a clamping device. In re Dailey and Eilers, 149 USPQ 47 (1966).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examine felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER